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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/665,534	09/19/2000	Yasuyuki Yoshimura	423-P-027	5261
7277	7590	12/04/2003	EXAMINER	
HOWARD C. MISKIN C/O STOLL, MISKIN, & BADIE THE EMPIRE STATE BUILDING 350 FIFTH AVENUE SUITE 4710 NEW YORK, NY 10118			SHOSHO, CALLIE E	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 12/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/665,534	YOSHIMURA ET AL.	
	Examiner	Art Unit	
	Callie E. Shosho	1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 7/28/03; teleph. interview 11/20/03.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13-26 and 28-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-11, 13-26 and 28-32 is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 33 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All   b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
 a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- |                                                                                              |                                                                                                                         |
|----------------------------------------------------------------------------------------------|-------------------------------------------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) <sup>of</sup> <del>Paper No.</del> <u>11/20/03</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                                             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other:                                                                                      |

*Allowable Subject Matter*

1. Present claims 1-11, 13-26, and 28-32 are allowable over the "closest" prior art EP 600205, JP 10077438, and JP 07118592 for the following reasons:

EP 600205, JP 10077438, and JP 07118592 each disclose aqueous inks comprising water, solvent, colorant, water-soluble binder, and pearlescent pigment which is mica coated with titanium oxide or iron oxide. However, there is no disclosure or suggestion in any of the references of the ratio of smoothness on the particle surface to the median diameter of the pigment or any disclosure or suggestion of the surface coating ratio of the colorant covering the surface of the glittering particle's, i.e. pearlescent pigment, surface as required in the present claims and thus, no disclosure that the ratio of smoothness on the particle surface to the median diameter of the pigment is not greater than 0.011 or that the surface coating ratio is not greater than 80% as presently claimed. Further, there is no disclosure or suggestion in EP 600205, JP 10077438, or JP 07118592 of interspersing the glittering particles within the range of not greater than 80% (claims 19, 23, 29) or within the range of 20-45% (claims 20 and 24).

In the previous rejections of record, the examiner argued that the ratio of smoothness on the particle surface to the median diameter of the pigment and the surface coating ratio of the colorant covering the surface of the glittering particle's surface were inherent to the pigments of each of EP 600205, JP 10077438, and JP 07118592. However, upon reconsideration and in light of the disclosures on pages 1-2 and 6 of the present specification, it is clear that there is no basis or evidence to support the position that the ratio of smoothness on the particle surface to the

median diameter and the surface coating ratio of the colorant covering the surface of the glittering particle's surface are inherent features of any of the cited references.

Specifically, the paragraph bridging pages 1-2 of the present specification discloses that conventional glittering pigments including pearlescent pigments, which are the pigments disclosed by either EP 600205, JP 10077438, or JP 07118592, do not possess strong glittering feeling and spatial effect. Further, page 6 of the present specification discloses that even when the median diameter of the glittering particles is not less than 10  $\mu\text{m}$ , as is the case in each of EP 600205, JP 10077438, and JP 07118592, when the ratio of smoothness on the particle surface to the median diameter exceeds 0.011, the glittering feeling lowers. Further, page 6 discloses that when the surface coating ratio of the colorant covering the surface of the glittering particles exceeds 80%, the glittering feeling also lowers. Thus, it is the ratio of smoothness on the particle surface to the median diameter and/or the surface coating ratio of the colorant covering the surface of the glittering particle's surface that define the glittering particles of the present invention.

In light of the above and given that each of EP 600205, JP 10077438, and JP 07118592 discloses pearlescent pigments and given that none of the references discloses or suggests the ratio of smoothness on the particle surface to the median diameter and/or the surface coating ratio of the colorant covering the surface of the glittering particle's surface as presently claimed, it is clear that the glittering particles of each of EP 600205, JP 10077438, and JP 07118592 do not meet the requirements of the present claims. That is, while each of EP 600205, JP 10077438, and JP 07118592 discloses glittering particles, they are not the glittering particles required in the present claims which must possess the ratio of smoothness on the particle surface to the median

diameter and/or the surface coating ratio of the colorant covering the surface of the glittering particle's surface as required in the present claims.

Thus, it is clear that EP 600205, JP 10077438, or JP 07118592, either alone or in combination, do not disclose or suggest the present invention.

However, present claims 1-11, 13-26, and 28-32 cannot be passed to issue because the following formal matters require resolution.

#### **Formal Matters**

2. This application is in condition for allowance except for the following formal matters:

Claim 33 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 29. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

3. Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

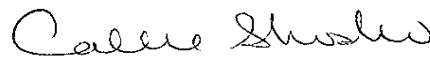
4. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

5. An interview was conducted with Ms. Gloria Tsui-Yip on 11/20/03. However, since no response to the examiner's request has been forthcoming as of this date, this office action is the result.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 703-305-0208. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Callie E. Shosho  
Primary Examiner  
Art Unit 1714